

REMARKS

Claims 1-12 are all the claims pending in the application. Claim 1 is the only independent claim.

Formal Matters

Applicant thanks the Examiner for acknowledging the claim for foreign priority and receipt of the priority document.

Applicant respectfully requests the Examiner to forward a copy of the PTO/SB/08 A & B form that was originally submitted with the Information Disclosure Statement filed on December 28, 2001 and is concurrently resubmitted with the Request For Acknowledgment Of Information Disclosure Statement.

The Examiner has objected to the Title of the Invention, alleging that it is not descriptive. Although Applicant disagrees with the Examiner, Applicant has amended the title as suggested by the Examiner.

In addition, the Examiner has objected to the abstract, alleging that it is too long. Applicants respectfully request the Examiner to withdraw the objection in view of the fact that the Abstract is only 149 words.

Allowable Subject Matter

The Examiner has indicated that claim 7 would be allowable if rewritten in independent form including all of the limitations of the base claim and intervening claims. Although Applicant thanks the Examiner for indicating that claim 7 would be allowed if rewritten in

independent form, Applicant holds in abeyance the rewriting of claim 7 until the Examiner has had a chance to consider the remarks below with respect to the rejection of independent claim 1.

Double Patenting

Claims 1-6 and 8-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 1-4 of *commonly owned* U.S. Patent No. 6,315,438 to Shirai et al. ("US '438"). It is the Examiner's position that although the claims of US '438 are not identical to the claims of the present application, that they are not patently distinct from each other. Applicant respectfully traverses this rejection in light of the fact that the claims of the present invention are directed to an invention that is patently distinct from that claimed in US '438.

Claim 1

For example, it is the Examiner's position that the "elastic water proofing rib" of claim 1 of US '438 is equivalent to the claimed "elastic locking portion" that 1) is operable to pass through the screw insertion hole by being deformed elastically to an inner side in a radial direction and 2) is on a front end side of the supported portion.

In forming the rejection, the Examiner acknowledges that the waterproofing rib (34a) (elastic locking portion) is not on the "front end side" of the supporting portion, but alleges that it would have been obvious to modify the invention claimed in US '438 so that the elastic waterproofing rib is in the front end side because it has been held that mere rearrangement or reversal of parts involves only routine skill in the art. The Examiner relies solely on *In re*

Japiske, 86 USPQ 70 (CCPA 1950) and *In re Einstein*, 8 USPQ 167¹⁶, as the rationale for modifying the claims of US '438. The Examiner's reliance on *Japiske*, however, is misguided because these cases are limited to situations where shifting the position of a structure does not modify the operation of the device. See *In re Japiske*, 86 USPQ at 73.¹ 10

With respect to claim 1, there would have been no motivation or suggestion at the time of invention to modify the elastic waterproofing rib claimed in US '438 so that the rib is instead on the "front end side" of the supporting portion. If one were to change the position of the waterproofing rib 34a described in US '438, the operation of the aiming screw is modified. In US '438, the waterproofing ribs 34a are positioned between the front end and rear end of the supported portion of the aiming screw so that they are capable of sliding on the inner surface of the screw insertion hole (see Figs. 5 and 8).

In contrast, the presently claimed "elastic locking portion" is at a front side of the supported position in order to allow the elastic locking portion to pass through the insertion hole by being deformed elastically to an inner side in a radial direction.

As such, Applicant respectfully requests the Examiner to withdraw the rejection of claim 1 at least because the claims of US '438 do not teach or suggest the claimed "elastic locking portion."

¹ Applicant has been unable to verify the existence of *In re Einstein* and respectfully requests the Examiner to provide a copy of this case to Applicant's representative if the Examiner continues to rely on *Einstein*.

Claim 2

In addition, Applicant respectfully request the Examiner to withdraw the rejection of claim 2 at least because of its dependency from claim 1 and because there is no teaching or suggestion that the “elastic waterproofing rib” (elastic locking portion) of the claims of US ‘438 engages with a peripheral edge portion on a *front end side* of the screw insertion hole. Instead, the elastic waterproofing rib of the claims of US ‘438 is merely slidable on an *inner surface* of the screw insertion hole, but is not capable of engaging a front end side of the screw insertion hole.

The fact that the presently claimed elastic locking portion engages with a *front end side* of the screw insertion hole prevents the aiming screw from drawing in a rear direction (see Fig. 7).

Claims 3-6 and 8-12

Finally, Applicant respectfully requests the Examiner to withdraw the rejection of claims 3-6 and 8-12 at least because of their dependency from claim 1.

Conclusion


In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
Appln. No. 10/029,203

Docket No. Q67944
Art Unit 2875

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


John M. Bird
Registration No. 46,027

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE



23373

PATENT TRADEMARK OFFICE

Date: June 30, 2003

AMENDMENT UNDER 37 C.F.R. § 1.111
Appln. No. 10/029,203

Docket No. Q67944
Art Unit 2875

APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE TITLE:

The title is changed as follows:

~~REFLECTOR-MOVABLE TYPE-HEADLAMP FOR~~ AUTOMOBILE WITH AIMING
SCREW HAVING LOCKING PORTION